

REMARKS:

Claims 1-35 are pending. Claims 1-35 are rejected. The first instance of claim 30 has been previously canceled; the second instance of claim 30 is currently pending.

Claim Amendments

Claims 1, 8, 12, 16, 20, 28 and 33-34 are amended with clarifying amendments. These amendments are supported throughout the specification, for example, page 8, line 21 to page 9, line 2; and in Figure 4.

Claims 7 and 15 are canceled without prejudice or disclaimer.

No new matter is added.

Information Disclosure Citation Form Previously Submitted

The Applicants respectfully request the Examiner indicate whether the Supplemental Information Disclosure Statement mailed Oct. 08, 2007 and marked as received on Oct. 11, 2007 by PAIR has been considered by the Examiner, or if not, why the Supplemental Information Disclosure Statement has not been considered. Attached please find a courtesy copy of the submitted form PTO-1449.

Claim Rejection - 35 U.S.C. 103(a)

The Examiner has rejected claims 1-19 as being unpatentable under 35 U.S.C. 103(a) over Lin et al. (U.S. Patent Pub. No. 2005/0096071), herein Lin, in view of Lielbriedis (U.S. Patent Pub. No. 2001/0051528), herein Lielbriedis; and claims 20-29 and 30-35 as being unpatentable under 35 U.S.C. 103(a) over Lin in view of Lielbriedis in further view of Hansmann et al. (U.S. Patent Pub. No. 2001/0016835), herein Hansmann. The Applicant includes the following comments to clearly distinguish the claimed invention over the art cited by the Examiner, and respectfully requests a favorable reconsideration of claims 1-6, 8-14, 16-29 and 30-35.

These rejections are respectfully disagreed with, and are traversed below.

It is well established law that in order for an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case for obviousness. Thus, as

interpreted by the Courts, the Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that in accordance with *In re Lee*, the prior art must contain a suggestion, teaching, or motivation for one of ordinary skill in the art to modify a reference or combine references; and that the proposed modification must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made.¹

Regarding claim 1 , which recites:

“A method comprising:
in the terminal of a first party participating in a telephone call, storing, as a consequence of the telephone call, identifier data that identifies a second party participating in the telephone call;
using the stored identifier data to determine automatically a destination address for a data message; and
sending, during the telephone call, a data message with the automatically determined destination address,
wherein using the stored identifier data to determine automatically the destination address for the data message comprises automatically **interrogating a database using the stored identifier data to obtain the destination address**”
(emphasis added).

As noted by the examiner, Lin does not directly disclose “storing an identifier and using the stored identifier to automatically determine a **destination address** for a data message” as in claim 1. Likewise, Lin does not disclose or suggest “interrogating a database using the stored identifier data to obtain the destination address” as in claim 1.

Lielbriedis discloses the use of an SMS message to notify a user at a mobile terminal that an email addressed to the user has arrived at a server. The user accesses “the stored e-mail by using the reply-function of the mobile communication station 210 for replying to the received SMS message”. The “originating address of the received SMS message will be used as the destination address of the responding SMS message” (see paragraph [0040]).

Lielbriedis appears to disclose a reply to an SMS and therefore fails to disclose “storing, **as a**

¹ *In Re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Agmen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996); *In Re Sang Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

consequence of the telephone call, identifier data that identifies a second party **participating in the telephone call**” and “using the stored identifier data to determine automatically a destination address for a data message” as in claim 1.

Lielbriedis does not appear to be concerned with a method of mapping information stored as a consequence of one type of communication onto an address used for another type of communication. Clearly, Lielbriedis does not disclose or suggest “interrogating a database using the stored identifier data to obtain the destination address” as in claim 1.

Additionally, Lielbriedis does not disclose or suggest “sending, **during the telephone call**, a data message with the automatically **determined destination address**” as in claim 1.

Neither Lin nor Lielbriedis, disclose or suggest “storing, **as a consequence of the telephone call**, identifier data that identifies a second party **participating in the telephone call**” and “using the stored identifier data to determine automatically a **destination address** for a data message” by “**interrogating a database** using the stored identifier data to obtain the destination address” as in claim 1. Clearly, even if one were to combine Lin and Lielbriedis (which the Applicants do not assert there is a motivation or teaching to do), the combination of Lin and Lielbriedis, herein Lin-Lielbriedis, also would not disclose or suggest “storing, **as a consequence of the telephone call**, identifier data that identifies a second party **participating in the telephone call**” and “using the stored identifier data to determine automatically a **destination address** for a data message” by “**interrogating a database** using the stored identifier data to obtain the destination address” as in claim 1.

Furthermore, it is unclear how one would combine Lin and Lielbriedis. Would the combination send the “SMS message” of Lielbriedis over “a voice channel during a telephone call” as in Lin? This would still not disclose or suggest claim 1.

For at least these reasons, claim 1 is in condition for allowance. As claim 12 recites similar language to that discussed above with reference to claim 1, claim 12 is likewise in condition for allowance. As claims 2-6, 8-11, 13-14 and 16-19 depend upon claims 1 and 12, they are likewise in condition for allowance.

Regarding claim 20, which recites:

“A method comprising, in a terminal of a first party participating in a telephone call:
providing, while the telephone call is on-going, a user selectable option to **set up a new channel that runs in parallel with a voice channel** used for the telephone call and to transfer data to another party participating in the telephone call via the new channel, without user specification of a destination address” (emphasis added).

As seen above, Lin “specifically relates to the transferring of data **over a voice channel**” and so fails to disclose “providing, while the telephone call is on-going, a user selectable option to **set up a new channel that runs in parallel with a voice channel**” “without user specification of a destination address” as in claim 20. Rather, the teaching in Lin appears to be in direct contradiction to “transfer data to another party participating in the telephone call via the new channel” as in claim 20.

Also, as seen above Lielbriedis discloses SMS communications rather than phone calls. It also discloses the use of the same channel for both communications, Clearly, Lielbriedis fails to disclose “providing, while the telephone call is on-going, a user selectable option to **set up a new channel that runs in parallel with a voice channel**” “without user specification of a destination address” as in claim 20.

Hansmann does not disclose how the parallel data channel is set up. Thus, Hansmann fails to disclose the ad-hoc feature of “providing, while the telephone call is on-going, a **user selectable option to set up a new channel that runs in parallel with a voice channel**” “without user specification of a destination address” as in claim 20.

Neither Lin, Lielbriedis nor Hansmann, disclose or suggest disclose “providing, while the telephone call is on-going, a user selectable option to **set up a new channel that runs in parallel with a voice channel**” “without user specification of a destination address” as in claim 20. Clearly, even if one were to combine Lin, Lielbriedis and Hansmann (which the Applicants do not assert there is a motivation or teaching to do), the combination of Lin, Lielbriedis and

Hansmann, herein Lin-Lielbriedis-Hansmann, also would not disclose or suggest “providing, while the telephone call is on-going, a user selectable option to **set up a new channel that runs in parallel with a voice channel**” “without user specification of a destination address” as in claim 20.

For at least these reasons, claim 20 is in condition for allowance. As claim 28 recites similar language to that discussed above with reference to claim 20, claim 28 is likewise in condition for allowance. As claims 21-27, 29, 30-32 and 35 depend upon claims 20 and 28, they are likewise in condition for allowance.

As claims 33 and 34 recites similar language to that discussed above with reference to claim 1, claim 33 and 34 is likewise in condition for allowance over Lin-Lielbriedis.

As seen above, Lin-Lielbriedis does not disclose or suggest claim 1. As claims 33 and 34 recite similar language to that discussed above with reference to claim 1, claims 33 and 34 should also be allowable over Lin-Lielbriedis, whether considered alone or in combination with other art cited as applied by the Examiner. For at least this reason, claims 33 and 34 are in a condition for allowance.

Furthermore, the Examiner does not identify the basis for citing Hansmann against claims 33 and 34

In light of the discussion above, the Applicant respectfully asserts that a prima facie case for obviousness was not presented as required by the court in *In re Lee*. As such, the Applicant respectfully requests that the Examiner reconsider and withdraw these rejections to claims 1-6, 8-14, 15-29 and 30-35.

For the foregoing reasons, the Applicant believes that each and every issue raised by the Examiner has been adequately addressed and that this application is in condition for allowance. As such, early and favorable action is respectfully solicited.

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